

## REMARKS

In the Office Action mailed March 1, 2004 the Examiner noted that claims 1-24 were pending, and rejected claims 1-24. Claims 1, 3, 8, 10, 15, 17 and 22 - 24 have been amended, and claims 2, 6, 9, 13, 16 and 20 have been canceled, and, thus, in view of the forgoing claims 1, 3-5, 7,8, 10-12, 14, 15, 17-19 and 21-24 remain pending for reconsideration which is requested. No new matter has been added. The Examiner's rejections are traversed below.

In the Office Action the Examiner rejected claims 1-22 under 35 U.S.C. section 112 paragraph 2 as indefinite, particularly noting claims 1, 8, 15 and 22. Claims 1, 8, 15 and 22 have been amended in consideration of the Examiner's comments and it is submitted they satisfy the requirements of the statute. If additional concerns with the claims arise, the Examiner is invited to telephone to resolve the same. Suggestions by the Examiner are also welcome. Withdrawal of the rejection is requested.

Ching provides a system in which a user/purchaser who has a receipt from a store can scan the receipt and store the receipt as an image ("a discrete file") in a database. The original electronic receipt (or receipt text file) is not stored in this database as it is not available to the user since it is held by the store. The Ching system also scans a "machine readable dataform" area of the receipt and OCR converts any handwritten text in the dataform area (a particularly prescribed area) into text data and this text data is also stored in the database. Ching only allows notes to be written in the prescribed area. The Examiner appears to be comparing the image created by the scanning of the receipt in Ching with the electronic document of the present invention.

In the present invention an electronic document, such as a text document in Word™, can be printed out on paper. The present invention allows the paper version of the electronic document to be scanned into a computer. The paper version can include a handwritten note. The note can be written or located anywhere on the printed document. In particular, the electronic document does not include the handwritten note when the electronic document is printed. Thus, the comparison of the electronic document of the invention which does not include the note with the scanned version that does include the note in Ching is inappropriate. The system of the present invention also extracts the note from the paper document and stores the note with a link to the electronic document (not with a link to the image file of the scanned document). The note can be located anywhere on the document because the system of the invention removes the electronic document ("a preprint" see specification page 8) from the scanned image of the paper document. In particular, this is done by determining a difference

between the electronic document (or an image version of the electronic document) and the scanned printed document that includes the note. By using such a difference the original document is removed leaving the note. This particularly allows the note to be anywhere on the printed document. Ching does not teach or suggest this. These features are emphasized in claims 1 8, 15, 22, 23 and 24.

The dependent claims depend from the above-discussed independent claims and are patentable over the prior art for the reasons discussed above. The dependent claims also recite additional features not taught or suggested by the prior art. For example, claims 7, 14 and 21 emphasize that the location of the handwritten note on the printed document is determined and indicated. Ching has no need for determining the location of a note since a note can only be located in the prescribed dataform area. It is submitted that the dependent claims are independently patentable over the prior art.


It is submitted that the claims satisfy the requirements of 35 U.S.C. 112. It is further submitted that the claims are not taught, disclosed or suggested by the prior art. The claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.

Respectfully submitted,

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Date: 6/1/4

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